

Attorney Docket No.: 069131.0102
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PATENT

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In re Application of:

Alvin C. Allen, Jr.

Serial No.: 09/206,627

Filed: December 7, 1998

For: APPARATUS AND METHOD FOR
TRIGGERABLE LOCATION
REPORTING

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Group Art Unit: 2683

Examiner: R. Perez-Gutierrez

Att'y Docket: 069131.0102

Technology Center 2600

Honorable Commissioner for Patents
Washington, D.C. 20231
**Attention: Board of Patent Appeals
and Interferences**

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TRANSMITTAL LETTER

Dear Sir:

Applicant hereby submits the following to be filed with the United States Patent and Trademark Office:

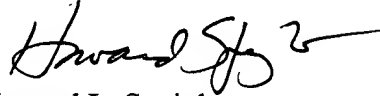
1. Reply Brief; and
2. Postcard.

Please date stamp and return the enclosed postcard evidencing receipt of these materials.

2002 MAY 01 9 33 AM
COMMUNICATIONS SECTION

The Commissioner is authorized to debit Deposit Account No. 02-0383 for any underpayment of fees which may be due in association with this filing.

Respectfully submitted,



Howard L. Speight
Reg. No. 37,733

Baker Botts L.L.P.
One Shell Plaza
910 Louisiana
Houston, TX 77002-4995
(713) 229-2057
(713) 229-2757 (fax)
April 26, 2002

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Under this interpretation, *Janky* teaches making contact between the IS responder/transmitter means 27 and an IS contact receiver 43 and then transmitting vehicle location data therebetween. *Janky* does not teach transmitting vehicle location information and then terminating the contact between the IS responder/transmitter means 27 and the IS contact receiver 43. Consequently, *Janky* does not teach disabling its telemetry transmitter after transmitting a location signal, as required by claim 26.

In the Examiner's Answer, the Examiner relied on the following sentence from *Janky*'s specification:

"The vehicle present location information can be updated continuously or intermittently, or the IS responder/transmitter means 27 may contact the IS contact receiver 43 only once." Column 12, lines 23-27.

According to the Examiner, this sentence "means that the vehicle present location information can be either:

- a) continuously transmitted to the IS contact receiver 43;
 - b) intermittently transmitted to the IS contact receiver 43; or
 - c) transmitted only once to the IS contact receiver 43, as desired."
- Examiner's Answer at 13-14 (emphasis removed).

A better understanding of this sentence can be derived from a subsequent sentence in the same paragraph:

"When the IS response signal is received, preferably with acknowledgement, at the IS contact receiver 43, the IS responder means 43 [sic 27] may discontinue sending vehicle present location information or may send such information continuously or intermittently." Column 12, lines 38-42

This statement implies that within a single contact, present location information will be transmitted until acknowledged and thereafter continuously, intermittently, or not at all, perhaps depending on the acknowledgement signal. There is, however, no teaching in *Janky* that the contact is terminated after transmitting the present location information signal. And, because the IS responder/transmitter means 27 must be enabled to maintain the contact, *Janky* does not teach disabling the IS responder/transmitter means 27 after transmitting the present location information. Consequently, *Janky* does not teach that its telemetry transmitter is disabled after transmitting the location information, as required by Claim 26. Therefore, Claim 26 is patentable over *Janky*.

2. Even if *Janky* is Found to Teach Disabling its Telemetry Transmitter After Transmitting a Location Signal, it Does Not Expressly or Inherently Teach or Suggest that the Enable Controller Does the Disabling.

Even if the Board rules that *Janky* teaches disabling its telemetry transmitter, *Janky* does not teach, explicitly or inherently, that the controller does the disabling. The Examiner implicitly admits *Janky* contains no explicit teaching by arguing that the teaching is inherent.

The Examiner and the Applicant disagree on the test for inherency, both quoting text from *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 20 USPQ2d 1746 (Fed. Cir. 1991), with the Applicant relying on the following language:

[t]o serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. ... Inherency ... may not be established by probabilities or possibilities. The mere fact that a certain fact *may* result from a given set of circumstances is not sufficient."¹

And the Examiner arguing that inherency can be established if:

The disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the question function.

The result should be the same under either formulation.

That is certainly true in this case. The controller in *Janky* does not necessarily disable the telemetry transmitter after the telemetry transmitter transmits the location information nor is this a "natural result flowing from the operation as taught."

While there is some indication in *Janky* that the controller enables the LDS signal receiver/processor 31, Column 11, lines 31-40, there is no teaching or suggestion that the LDS signal receiver/processor 31 and the IS responder/transmitter means 27 are disabled once they are enabled, as described above. Even if they are, however, there is no teaching or suggestion in *Janky* that the controller does the disabling.

It is just as likely, if not more likely, that the controller is not involved and that the LDS signal receiver/processor 51 and the IS responder/transmitter means 27: (1) disable themselves; (2) are disabled by another device in the system, not the enable controller; or (3) are manually

¹ The Board recently relied on this same language in a non-precedential opinion in *Bronshtein v. Roser*, Patent Interference 104,727 (Board of Patent Appeals and Interferences, January 2, 2002).
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disabled. Thus, the requirement in Claim 26 that the controller disable the location-signal generating device and the telemetry transmitter after the telemetry transmitter transmits the location signal is not inherent in *Janky*.

This is even more clear in light of the fact that *Janky* indicates that the controller is optional, Column 12, lines 52-53 and 66-67, without describing a change in functionality with respect to enabling and disabling the LDS receiver/processor and the IS responder/transmitter means. Thus, even assuming *Janky* teaches disabling these components, it teaches away from having the controller do the disabling. Thus, *Janky* does not teach or suggest, explicitly or inherently, that the controller disables the location signal generating device and the telemetry transmitter after the telemetry transmitter transmits the location signal, as required by Claim 26. Consequently, Claim 26 is patentable over *Janky*.

Claims 27-33 depend from Claim 26 and are patentable for at least the same reasons.

The rejections of Claims 26-33 should be reversed.

3. Claims 1-11, 14, 16-22, 24 and 25 are Patentable for the Same Reasons.

The examiner rejected claims 1-11, 14, 16-22, 24 and 25 under 35 USC 103(a) as being unpatentable over *Janky* et al. (U.S. Patent Number 5,777,580) in view of Westerlage et al. (U.S. Patent Number 5,826,195). Claim 1 requires "an enable controller being configured to disable the GPS receiver and the cellular network transmitter." Claim 19 requires "disabling the GPS receiver and the cellular network transmitter."

In rejecting claims 1-4, 19, 20 and 22, the examiner made essentially the same inherency argument as with claim 26: that *Janky* inherently shows "the controller 25 (enable controller) being configured to put back to sleep (disable, switch off) the LDS receiver/processor 31 (GPS receiver) and the IS communications transmitter or responder means 27 (cellular network transmitter)."

As discussed above with respect to claim 26, *Janky* does not include this feature either expressly or inherently. The examiner implicitly admitted that Westerlage does not include this feature, which means that the examiner's proposed combination of *Janky* and Westerlage would not include this feature. Thus, claims 1-4, 19, 20 and 22 would not have been obvious to a person of ordinary skill at the time this application was filed over *Janky* in view of *Westerlage*. Thus, claims 1-4, 19, 20 and 22 are patentable over *Janky* in view of *Westerlage*.

Claims 3-11, 14, 16-18, 21 and 23-25 depend from one or more of claims 1-4, 19, 20 and 22, and are patentable for at least the same reasons. The rejection of claims 1-11, 14, 16-22, 24 and 25 should be reversed.

Respectfully submitted,



Howard L. Speight

Reg. No. 37,733

Baker Botts L.L.P.

910 Louisiana

Houston, Texas 77002

Telephone: (713) 229-2057

Facsimile: (713) 229-2757

ATTORNEY FOR APPLICANT

Date: April 26, 2002